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Examiner Name	Fred I. Ehichioya
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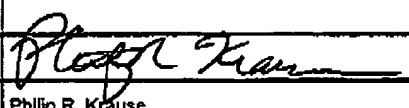
Signature			
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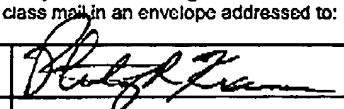
Signature			
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In the United States Patent and Trademark Office

Appn. Number:	09/759,215
Appn. Filed:	January 16, 2001
Applicants:	Thomas W. Krause and Philip R. Krause
Customer #:	35197
Title:	Method and apparatus for providing customized date information
Examiner/GAU:	Fred I. Ehichioya/2162
Date:	August 7, 2006

Reply Brief

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The attached Reply Brief is submitted pursuant to 37 CFR 41.41. The corresponding notice of appeal was filed on January 4, 2006, the appeal brief was filed on March 6, 2006, and the USPTO's Examiner's Answer Brief was mailed on June 6, 2006.

REPLY BRIEF

In this Reply Brief, after presenting a brief summary of the arguments to aid the Board's consideration of the issues, the Appellant will consider the specific arguments made in the Appeal Brief of March 6, 2006, and explain the deficiencies in the USPTO's Examiner's Answer Brief of June 6, 2006 with respect to these arguments and issues. The Appellant's arguments fall into four main categories, organized from A-D:

A. The Examiner's combination of NETG and Ruane does not disclose the claimed invention (Appeal Brief pages 11-18).

B. Even if the combination of NETG and Ruane disclosed the claimed invention, combination of these references would be inappropriate, because

1) they are non-analogous art (Appeal Brief pages 18-20).

2) No motivation to combine with the other reference is described in either NETG or Ruane. NETG and Ruane are individually complete—thus further demonstrating lack of motivation to combine in the absence of any specific motivation cited by the examiner. (Appeal Brief pages 20-23).

3) As a work of fiction, Ruane is not an invention, and is not enabled by Ruane's description (Appeal Brief page 23).

C. The Examiner ignores definitions provided in the specification of terms used in the claims, such as "age-event information", and "celebrity ageliner", and substitutes his own definitions that are unsupported by the specification or any previous use of these terms. These terms have no meaning outside the specification, and thus, the specification is the appropriate place to look for the meaning of these terms. (see, in particular, Appeal Brief pages 16-18 and 23-25).

D. Rejection of dependent claims is inappropriate, either due to failure to disclose claim limitations or to describe appropriate motivation to combine references (Appeal Brief pages 23-36).

Discussion of Examiner's Responses to Appellant's arguments (starting on Answer Brief, page 13).

A. In response to the Appellant's argument that specific limitations in claims 1, 14 and 18 are not described in the prior art relied on in the rejection, the examiner addresses several subpoints from the Appeal Brief

(1) *The information provided by NETG does not comprise the age of a first individual on a specific date, but merely regurgitates a birthdate that was input in step a). (Page 12, paragraph 1)*

This argument by the Appellant explained why NETG does not disclose step b) of the invention. The Examiner's answer claims that NETG discloses an input signal, which represents step a) of the invention. Thus, this counter-argument is irrelevant to the Appellant's argument that NETG does not disclose step b).

(2) The information provided by NETG does not comprise the age of a first individual on a specific date (page 12, paragraph 1)

The examiner states that NETG (on page 10) determines an age in days, based upon an input signal (August 30, 1955). In NETG, this is the age of the individual on the date that NETG's program is used. While this does represent an age on a specific date, subsequent steps in the Appellant's invention require the age on that specific date to be used in a particular way, which NETG does not do.

(3) This age information used by NETG does not comprise the age of a first individual on a specific date. .. Also, as specified in the claim, to meet the limitation of step c), the "age-event" information must comprise information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date. . .. Thus NETG does not disclose step c) (page 13, paragraph 1).

The examiner states that NETG searches the database and displays "Your birthday is Tue 30-Aug-1955" which is the age-event information corresponding to said age. However, step c) requires a database to be searched for age-event information corresponding to said age information (as determined in step b). The output from NETG ("Your birthday is Tue 30-Aug- 1955") is not the result of a database search in NETG. Moreover, this output does not constitute age-event information, as defined in the claim and specification (see also Section C of this Reply Brief).

The Examiner here introduces the new argument that Ruane discloses step c). However, Ruane, as a work of fiction, is not enabled. Ruane describes an output (the "personalized calendar" cited by the Examiner), but does not describe any database search that meets the limitations of step c). Thus, neither NETG nor Ruane discloses step c). The Examiner provides no rationale or motivation for arriving at step c) based upon a vague combination of NETG and Ruane ("Ruane's idea shows a first and second person while NETG calculates ages based on the input signal in this combined invention"), and the Appellant can discern no rational basis for arriving at step c) based upon this combination. Please see also Section B.2 of this Reply Brief for a discussion of absence of motivation to combine NETG and Ruane.

(4) The O.A. does not describe an output signal in NETG that comprises age-event information (page 14, paragraph 1).

The Examiner here states that NETG discloses an output signal. However, the Examiner does not demonstrate any output signal of NETG that comprises age-event information, as defined in the wherein clause or in the specification. Although the Examiner here cites Section 9 of the Answer Brief, nowhere in the Answer brief is it shown where NETG provides an output signal that comprises age-event information (see also Section C of this Reply Brief). The Examiner here further states that Ruane discloses an output signal that is "personalized calendar", but to meet the limitation of step (d), the output signal must comprise age-event information corresponding to said age information [of step (b)], which Ruane does not disclose.

B. Features disclosed in one reference may not properly be combined with features disclosed in another reference to arrive at claims 1, 14 or 18.

1. The Appellant argued that Ruane is not analogous art to NETG and would not have been known or considered by a person with ordinary skill in the art (page 18, paragraph 2). . . .Examiner has not described any basis on which Ruane, a fictional article in an obscure literary journal, would logically have commended itself to an inventor's attention in the context of the present invention, and no such basis appears to exist (page 19, paragraph 2).

In response, the Examiner cites requirements to show motivation to combine references. The Examiner further states that "One of ordinary skills will recognize that there is some teaching, suggestion, or motivation to combine

However, this argument is already addressed in the Appeal Brief, pages 20-21. Briefly, this motivation comes from Ruane, a fictional short story. While one character in this story believes that there could be a market for the calendar described by Ruane, his brother (Peter) expresses significant doubt regarding the value of this calendar. This casts significant doubt on Ruane's seriousness in proposing a potential market as a motivation even for his own description, much less any combination with other art. Moreover, nothing in Ruane's description points to a motivation for a specific combination with NETG, which would be required in order for Ruane to provide motivation for this combination. Notably, the Examiner identifies no other potential motivations to make this combination.

Moreover, NETG and Ruane are individually complete (Appeal Brief, page 22). Neither is missing anything that a reader of either reference would logically search for in the other reference, further indicating lack of motivation to combine. The Examiner again asserts that because it is possible to combine references, they can be combined. However, even if they can be combined, they may not be combined in a Section 103(a) rejection without explaining why an individual with ordinary skill would be motivated to make that specific combination (in addition to the other references cited in the Appeal Brief, please also see the detailed summary of court decisions and logic supporting the decision in In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

(4) Ruane is not an invention.

these references. The motivation is that this combination "with the right equipment and business strategy, will sure make a fortune" as suggested by Ruane (page 5, paragraph 8). This counter-argument is completely irrelevant to the Appellant's argument that NETG and Ruane are non-analogous, and thus may not be combined. Before searching for motivation to combine references, it is necessary to demonstrate that the art is analogous.

The Examiner acknowledges that Ruane is fictional, yet without any support for this assertion, claims that Ruane intended to set forth an invention in a fictional setting. He summarizes part of Ruane's story line, and again repeats a supposed motivation to combine. None of these arguments address whether NETG and Ruane are analogous art.

The Examiner has never demonstrated that these works are analogous, and, as pointed out in the Appeal Brief (pages 18-20), these works are not analogous and thus may not be combined, regardless of motivation.

(2) No convincing motivation to combine NETG with Ruane is described in the references or in the knowledge generally available to one of ordinary skill in the art (Appeal Brief, page 20).

The Examiner again asserts that "the motivation to combine references is that a "personalized calendar" which shows "on each day there's some notable achievement done by a person who is exactly as old as you are on that day" is produced. With the right equipment and business strategy, fortune will surely be made."

The Examiner asserts without evidence that Ruane does constitute an invention, first expressed in a fictional work. However, the Examiner does not address the Appellant's argument that Ruane contains no enablement, and also appears to be unable to cite any U.S. Board or court decision in which an Examiner's reliance on a work of fiction in an obviousness rejection has been considered, much less upheld. Thus, no basis is provided that would justify consideration of Ruane as an invention that can be used to support a Section 103(a) rejection.

C. The Examiner ignores definitions provided in the specification of terms used in the claims, such as "age-event information", and "celebrity ageliner", and substitutes his own definitions that are unsupported by the specification or any previous use of these terms. These terms have no meaning outside the specification, and thus, the specification is the appropriate place to look for the meaning of these terms. (see, in particular, Appeal Brief pages 16-18 and 23-25).

In describing the present invention, the Appellant used several terms not in general use, such as "age-event information" and "celebrity ageliner". The Examiner argues that these terms can be defined by the Examiner without reference to the specification (or even the wherein clause of claim 1). For example, the Examiner asserts that "Your birthday is Tue 30-Aug-1955" (Answer

brief, page 14) or that "Happy Anniversary" (Answer Brief, page 20) constitutes age-event information, even though the wherein clause of claim 1 states:

> wherein said age information comprises the age of a first individual on a specific date and said age-event information comprises information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date.

The Examiner never identifies the event or the two individuals that this supposed age-event information is believed to include. Moreover, the specification also provides definitions of these terms that the Examiner ignores, instead claiming that the Applicant cannot rely on the specification to impart to the claims limitations not recited therein (see, for example Answer Brief, pages 17 and 19).

Relying on the specification to define terms not commonly in use is completely different from relying on the specification to impart limitations not recited therein. As pointed out in the Appeal Brief (pages 17-18 and 23-25), the specification does provide definitions for age-event information and for celebrity ageliner. Moreover, as pointed out in the Appeal Brief, the patentee is permitted to be his own lexicographer (see Hormone Research Foundation Inc. v. Genentech Inc., 904 F. 2d 1558 (Fed. Cir. 1990)). Another case, Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005), provides a lengthy explanation of why terms in the claims are appropriately interpreted with reference to their definitions in the specification, a small part of which is excerpted here:

> Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such

> cases, the inventor's lexicography governs. See CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002). In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive. See SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1343-44 (Fed. Cir. 2001).

In this particular case, the terms "age-event information" and "celebrity ageliner" have no well-accepted meaning outside this specification and these claims. Google searches performed on August 6, 2006 revealed no hits in which these phrases were used on any website other than that of the Appellant. To the Appellant's knowledge, these terms appear in no dictionary. Thus, it is simply inappropriate for the Examiner to define these terms at will—the definitions provided by the Appellant in the specification and in the claims must hold.

D. Rejection of dependent claims is inappropriate, either due to failure to disclose claim limitations or to describe appropriate motivation to combine references (Appeal Brief pages 23-36).

1. Claims 2 and 15

From the specification, it is clear that the "individual" in the "celebrity ageliner" of claims 2 and 15 is a person distinct from the "celebrity". The Examiner argues that the Appellant's definition of the term "celebrity ageliner" in the specification constitutes an inappropriate imparting of limitations to the claims by the specification. For the reasons discussed in Section C, above, this

argument is incorrect. Moreover, the Examiner's counter-argument exhibits confusion about a celebrity ageliner. The celebrity is the person who is the same age as the historical figure was on the date at which the historical event occurred. Thus, in the Examiner's example, Jack Kerouac would be the historical figure. However, based upon the definition and the claims, "I" cannot be the celebrity.

2. Claim 4

The date displayed on page 10 is the input birthdate, not "specific date" from claim 1.

The Examiner here misquotes claim 4 as saying, "wherein the output signal further comprises a date." The actual claim 4 states "wherein the output signal comprises said specific date". Said specific date refers to the specific date in claim 1 (defining the date on which the age of the first individual is calculated, in order to identify the age-event information), which is not disclosed by the Examiner's example, which merely refers to the input date.

3. Claims 21 and 22.

Claim 21 refers to an input signal that includes a name. The Examiner states that "Jack Kerouac Park is the name of second individual that can be linked to a first individual". However, it is clear that Jack Kerouac is at best an output (if the non-enabled fictional description in Ruane can even be construed to have an output) of Ruane, and not an input signal. The Examiner's prior art does not

accept a name as input. None of the Examiner's counter-arguments address the original arguments in the Appeal Brief (pages 25-27).

4. Claims 8, 16 and 19.

Based on the definitions in the specification and claims, it is clear that "Happy Anniversary" cannot be construed as age-event information. The Examiner indicates a belief that using definitions in the specification to interpret the claims constitutes impermissible limitation of the claims based upon the specification. This is incorrect, based on the arguments in Section C above.

Moreover, the Appellant's argument that appropriate motivation to combine NETG, Ruane, and McDonald is not provided remains unaddressed.

5. Claim 12.

The Examiner agrees that McDonald, Figure 9, does not show age-event information, but continues to assert that McDonald, Figure 11 shows age-event information. However, the Appeal Brief (page 30) already explains why Fig. 11 (which shows the name Johnny Smith, his birthdate, and the amount of time elapsed since his birth), does not show age-event information or disclose claim 12—an argument that remains unrefuted by the Examiner.

6. Claim 13.

The Examiner mischaracterizes the Appellant's response as agreeing that Kendrick discloses age-event information. In fact, the Appellant demonstrates

convincingly (Appeal Brief, pages 30-33) that Kendrick does not disclose age-event information, and the Examiner does not refute those arguments.

7. Claims 11, 17 and 20.

The Examiner repeats the argument from the final O.A., and does not refute either the Appellant's explanation of why Slotznick does not disclose age-event information, or the Appellant's observation that no plausible motivation for combining Slotznick with the other references is provided (Appeal Brief, pages 33-35).

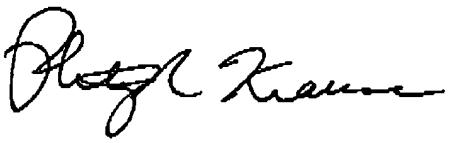
8. Claims 9 and 10

The Examiner states that the motivation to combine Slotznick with the other references is that "an electronic customized greeting cards can be dispensed in vending machine and kiosk. This is convenient for customers who can design, customized and personalized their greeting cards at their convenience with minimal fees." However, the ability to do something disclosed completely within Slotznick does not point specifically to any of the other references, as would be required for this to constitute motivation to combine these references. Thus, this argument adds nothing to the argument already refuted in the Appeal Brief (pages 35-36).

Conclusion

The arguments and evidence proffered by the Examiner do not support an obviousness rejection under U.S.C. Section 103, for the reasons set forth in the Appellant's responses to the Office Actions and in the Appeal Brief (and as also summarized in the current Reply Brief, presently submitted in response to the Examiner's Answer Brief). The Appellant thus respectfully requests reversal of all of the USPTO's rejections of the claims of the Appellant's application.

Very Respectfully,



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